



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/923,702 | 08/07/2001 | Fumitake Yodo | | 1747 |

7590 09/20/2002

Jay H. Maioli
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

FISCHER, ANDREW J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3627

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/923,702

Applicant(s)
Fumitake Yodo

Examiner
Andrew J. Fischer

Art Unit
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 9 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/600,509.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3627

DETAILED ACTION

Acknowledgments

1. The amendment filed July 23, 2002 (Paper No. 5) is acknowledged. Accordingly, claims 8 and 9 remain pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

3. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

a. In claim 8, it is unclear as what is the corresponding structure which makes up the “means for carrying out an other accounting processing” Applicant is respectfully requested to specifically point out in the specification and drawings (including the element numbers within the drawings) the elements which make up the corresponding structure.

b. Also in claim 8, it is unclear if the controller decrements the accounting points or the “accounting point information” as claimed. One of ordinary skill in the art would not know how to decrement “information.” It is believed Applicant intends to decrement the accounting points and not the “information.”

Art Unit: 3627

c. In claim 9, it is unclear as what is the corresponding structure which makes up the "means for carrying out an other accounting processing" Applicant is again respectfully requested to specifically point out in the specification and drawings (including the element numbers within the drawings) the elements which make up the corresponding structure.

d. Also in claim 9, it is unclear if "the request is for purchasing the accounting point information" is a request for purchasing additional accounting *points* or purchasing the *information*. It is believed Applicant's invention is a request for purchasing additional points and not purchasing *information* as claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

5. Claims 8 and 9, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Ushiki et. al. (U.S. 5,438,356). Ushiki et. al. discloses the following: terminal device (a personal computer) with a first memory (a first memory register inherent in virtually all computing devices) and a second memory (a second memory register also inherent in

Art Unit: 3627

virtually all computing devices), and a controller (the CPU); an accounting center (10) with its computer.

6. Claims 8 and 9, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura (U.S. 6,144,946). Iwamura discloses a terminal (an ordinary personal computer) with 1st and second memories (each memory address is different from the other memory addressees); a first controller (the CPU); a second controller (a modem or other communications device); the controller decrements the accounting points (when the user purchases an item, their account is decremented) and the item purchased becomes available to the user); the accounting center has a mean for carrying out account processing (a CPU within the a computer).

7. "A system is an apparatus." *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907).

Therefore, it is the Examiner's position that Applicant's system claims are clearly directed towards a product or machine claim.

8. In accordance with: the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¹* ("Guidelines"), MPEP §2181, the previous Office Action (mailed April 23, 2002, Paper No. 4, Paragraph No. 9), and because Applicant has removed some

¹ Federal Register Vol 65, No 120, June 21, 2000.

Art Unit: 3627

instances of “means for” from the claims while keeping others (e.g. claim 8 now recites “a controller” in line 8 while retaining “means for carrying out” in line 18), it is the Examiner’s position that phrases which recite “means for” are an express desire by Applicant to invoke 35 U.S.C. 112 6th paragraph. Additionally, the phrases which recite “means” only fail the first of three prongs (as recited in the Guidelines and MPEP §2181) needed to invoke 112 6th paragraph.

9. Functional recitation(s) using the word “for” (e.g. “for updating the accounting point information” as recited in claim 8) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

10. The Examiner notes that Applicant has declined the Examiner’s express invitation² to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the ex parte examination process, the presumption in favor of the ordinary and accustomed meaning is maintained and is now made final. The claims are therefore interpreted with their “broadest reasonable interpretation . . .” *In re Morris*, 127 F.3d

² See the Examiner’s previous Office Action mailed April 23, 2002, Paper No. 4, Paragraph No. 8.

Art Unit: 3627

1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).³ The Examiner now relies extensively on this interpretation.

11. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

³ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).


Art Unit: 3627


will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

14. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER


ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

AJF
September 17, 2002